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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,501	12/20/2001	Tsunefumi Takahashi	P21074	2848

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EXAMINER	
MOONEYHAM, JANICE A	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/022,501	TAKAHASHI, TSUNEFUMI	
	Examiner	Art Unit	
	Janice A. Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2001 and 21 February 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the application filed on December 20, 2001, wherein claims 1-14 are currently present with claims 3-8 and 10-11 being amended by the preliminary amendment filed on February 21, 2002.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on May 7, 2004 is being considered by the examiner.

Claim Rejections - 35 USC § 112

4. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-5 and 8-12 are directed to a method and medium for analyzing legal reasoning comprising the following steps:

determining an initial law corresponding to the legislative objective;

presenting an initial image that does not fit in with the initial law via the computer network, potentially obstructing the legislative objective; and

determining a second law by revising the initial law to remove the potential obstruction.

It is not clear how the determination of the initial law is performed? Who/what makes this determination?

Who or what determines the initial image that does not fit in with the initial law? How is this presented?

What happens if the initial image that does not fit in with the initial law does not obstruct the legislative objective?

Claims 3 reads:

presenting a proposed image that does not fit in via the computer network, the computer network being accessible by a plurality of participants;

receiving votes on whether the proposed image that does not fit in can be agreed upon as a nightmare;

presenting the proposed image that does not fit in as the initial image that does not fit in when the voting determines that a predetermined percentage of the plurality of participants agree that the proposed image that does not fit in can be agreed upon as a nightmare.

How is the proposed image that does not fit determined?

How is an agreement made that the proposed image that does not fit is a nightmare?

What happens if the voters determine that the image does not obstruct the legislative objective?

Claims 6-7 are directed to creating a legal map depicting legal reasoning, comprising the steps of:

presenting an objective of the law;

determining an initial law to represent the objective and depicting the initial law at a first position of a triangle;

presenting an image that does not fit in with the objective and depicting the image that does not fit in a second position of the triangle; and

deriving a second law that addresses the image that does not fit in with the objective and depicting the second at a third position of the triangle.

How is the determination of the initial law performed? Who/what makes the determination?

How is the image that does not fit determined and how is it presented?

How does this triangle depict legal reasoning?

Claim 7 is directed to:

depicting the second law at a first position of a second triangle;

presenting a second image that does not fit in with the second law and depicting the second image that does not fit in at a second position of the second triangle; and

deriving a third law that addresses the second image that does not fit in with the second law and depicting the third law at a third position of the second triangle.

How is the depicting of the law on the triangle performed? Who/what performs this step?

How is the image that does not fit determined and how is it presented?

Claims 13-14 claim identifying a last revised law of the consecutively determined plurality of revised laws as the final law.

How is the determination made that there is a final law?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant states that an initial/proposed image that does not fit in with the initial law is presented. What is an initial image? Is this a scenario?

Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What does the applicant define as a nightmare?

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. See detailed discussion below.

35 U.S.C. § 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter.

The applicant's invention is directed to a method, medium and apparatus/system and thus falls within an enumerated statutory class.

However, not all processes, mediums or apparatus/systems are statutory under 35 USC Section 101. To be statutory, a claimed process must either: (A) result in a physical transformation which a practical application is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application which produces a useful, tangible, and concrete result. See *Diehr,* 450 U.S. at 183-84, 209 USPQ at 6. To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways:

(a). The claimed invention "transforms" an article or physical object to a different state or thing.

(b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The Examiner must review the claims to determine if the claims provide a practical application that produces a useful, tangible and concrete result. In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete."

The Examiner asserts that the applicant's invention does not produce a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art.

The Examiner asserts that the applicant's invention is not repeatable or predictable. The invention is directed to presenting an objective, determining a law corresponding to the objective, presenting an image/scenario that potentially obstructs the objective and determining a second law by revising the initial law to remove the potential obstruction. The results of the invention cannot be assured since it involves the subjective mental steps of human beings. The Examiner asserts that the objective mental steps of a human being are not reproducible. The step of presenting an image

that does not fit in with the initial law is a subjective mental step. For each person performing the invention, there would be a different results would be produced. Thus, there is not reproducible or repeatable result.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 11-12 are rejected under 35 U.S.C. 102(a) as being anticipated by New Hampshire Tax Policy Analysis System (hereinafter referred to as New Hampshire).

Referring to Claim 11:

New Hampshire discloses a system, comprising:

a central processing unit that runs a computer program for the legal reasoning analysis and presents and receives information and determining a percentage (page 3); and

a server connected to the central processing unit, the server being accessible by a plurality of user terminals via a packet switched data network (page 7 database system resides on a server machine and supports any number of users).

Referring to Claim 12:

New Hampshire discloses a memory database connected to the central processing unit for storing data (page 3 databases).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 8-10 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over How Our Laws are Made by Charles W. Johnson (hereinafter referred to as Johnson) in view of New Hampshire Tax Policy Analysis System (hereinafter referred to as New Hampshire).

Referring to Claims 1 and 8:

Johnson discloses a method and medium for analyzing legal reasoning for determining a law, the method comprising:

presenting a legislative objective of the law (page (1) the brochure is a basic outline of the numerous steps for our federal lawmaking process from the source of an idea for a legislative proposal; page 3 sources of ideas of legislation are unlimited and proposed drafts of bills originate in many diverse quarters);

determining an initial law corresponding to the legislative objective (page 3 sources of ideas of legislation are unlimited and proposed drafts of bills originate in many diverse quarters; page 4 the work of Congress is initiated by the introduction of a proposal in one of four forms; page 7 any member may introduce a bill at any time);

presenting an initial image that does not fit in with the initial law, potentially obstructing the legislative objective (page (1) a proposal cannot become a law with

consideration and approval; page 10 consideration by committee request for official report of views on the necessity or desirability of enacting the bill into law; page 10 public hearings, committee meetings); and

determining a law by revising the initial law to remove the potential obstruction caused by the initial image that does not fit in with the initial law (page 13 reported bills – if the committee votes to report the bill favorably to the House).

Johnson does not disclose that the process is performed via a computer network. However, New Hampshire discloses a Tax Policy Analysis Computer System (pages 2-3 and 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the law making method and medium of Johnson the Analysis System taught in New Hampshire so as to allow state policymakers and analysts to both accurately and quickly determine the effects of both current and proposed State tax policies on new Hampshire residents and to provide a user interface that allows users to recall, store, and edit tax scenarios, submit policy comparisons and view the results of these comparisons.

Referring to Claim 2:

New Hampshire discloses presenting the law via a computer network (page 3).

Referring to Claim 3:

Johnson discloses presenting a proposed image that does not fit in (page 1 a proposal cannot become a law with consideration and approval; page 10 consideration

by committee request for official report of views on the necessity or desirability of enacting the bill into law; page 10 public hearings, committee meetings);

receiving votes on whether the proposed image that does not fit in can be agreed upon as a nightmare (page 22 consideration and debate; page 27-28 Voting);

presenting the proposed image that does not fit in as the initial image that does not fit in when the voting determines that a predetermined percentage of the plurality of participants agree that the proposed image that does not fit in can be agreed upon as a nightmare (page (1) a proposal cannot become a law with consideration and approval; page 10 consideration by committee request for official report of views on the necessity or desirability of enacting the bill into law; page 10 public hearings, committee meetings).

Referring to Claim 4:

New Hampshire discloses displaying substantially simultaneously via the computer network, the proposed image (page 2 provide a convenient interface for tax policy scenario design and editing).

Referring to Claim 9:

New Hampshire discloses a storing source code segment that stores legal reasoning data, the data comprising the objective, the law, the image that does not fit in, the data being accessible by a plurality of users via a data network (page 2-3 and 6-9).

Referring to Claims 5 and 10:

Johnson discloses receiving a law, derived from a law that accounts for the second image that does not fit in (page (1) a proposal cannot become a law with

consideration and approval; page 10 consideration by committee request for official report of views on the necessity or desirability of enacting the bill into law; page 10 public hearings, committee meetings).

Referring to claims 13-14:

Johnson discloses a method for analyzing legal reasoning for deriving a final law, the method comprising:

determining an objective of the final law (page (1) the brochure is a basic outline of the numerous steps for our federal lawmaking process from the source of an idea for a legislative proposal; page 3 sources of ideas of legislation are unlimited and proposed drafts of bills originate in many diverse quarters);

determining an initial law corresponding to the objective (page 3 sources of ideas of legislation are unlimited and proposed drafts of bills originate in many diverse quarters; page 4 the work of Congress is initiated by the introduction of a proposal in one of four forms; page 7 any member may introduce a bill at any time);

consecutively determining a corresponding plurality of revised laws that remove the potential obstructions (page (1) a proposal cannot become a law with consideration and approval; page 10 consideration by committee request for official report of views on the necessity or desirability of enacting the bill into law; page 10 public hearings, committee meetings); and

identifying a last revised law of the consecutively determined plurality of revised laws as the final law (page 13 reported bills – if the committee votes to report the bill favorably to the House).

receiving voting results regarding whether each one of a plurality of proposed scenarios comprises one of the plurality of scenarios that potentially obstruct the objective (page 22 consideration and debate; page 27-28 Voting).

Johnson does not explicitly disclose a plurality of scenarios. However, New Hampshire discloses a plurality of scenarios (page 2-3 tax policy scenario; page 6 manipulate tax policy scenarios).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the law making method disclosed in Johnson with the scenarios taught in New Hampshire so as to allow policymakers and analysts to accurately and quickly determine the effects of both current and proposed tax policies.

3. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson view of Eder (US 6,321,205) (hereinafter referred to as Eder).

Referring to Claim 6:

Johnson discloses a method, the method comprising:

presenting an objective of the law page ((1) the brochure is a basic outline of the numerous steps for our federal lawmaking process from the source of an idea for a legislative proposal; page 3 sources of ideas of legislation are unlimited and proposed drafts of bills originate in many diverse quarters);

determining an initial law to represent the objective (page 3 sources of ideas of legislation are unlimited and proposed drafts of bills originate in many diverse quarters;

page 4 the work of Congress is initiated by the introduction of a proposal in one of four forms; page 7 any member may introduce a bill at any time);

presenting an image that does not fit in with the initial law and depicting the image that does not fit in at a second position of the triangle (page (1) a proposal cannot become a law with consideration and approval; page 10 consideration by committee request for official report of views on the necessity or desirability of enacting the bill into law; page 10 public hearings, committee meetings); and

deriving a second law that addresses the image that does not fit in with the initial law (page 13 reported bills – if the committee votes to report the bill favorably to the House).

Johnson does not disclose creating a map. However, Eder discloses mapping (Figures 10-11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the legislative procedures disclosed in Johnson mapping as taught in Eder so as to display a forecast of impact of changes.

Referring to Claim 7:

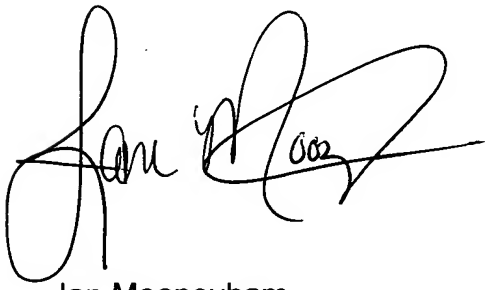
Johnson discloses presenting a second image that does not fit in with the second law and depicting the second image that does not fit in (page (1) a proposal cannot become a law with consideration and approval; page 10 consideration by committee request for official report of views on the necessity or desirability of enacting the bill into law; page 10 public hearings, committee meetings); and

deriving a third law that addresses the second image that does not fit in with the second law (page 13 reported bills – if the committee votes to report the bill favorably to the House).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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